



Jfw/1657

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Art Unit: 1654
)	
JANSSON, John-Olov)	Examiner: LUKTON, D.
)	
Appl. No.: 10/530,866)	Washington, D.C.
)	
Filed: April 11, 2005)	February 21, 2007
)	
For: USE OF GHRELIN FOR)	Docket No.: JANSSON=7
TREATING MALNUTRITION)	
IN GASTRECTOMIZED...)	Confirmation No.: 2241

SECOND SUPPLEMENTAL ELECTION WITH TRAVERSE

U.S. Patent and Trademark Office
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Sir:

1. In response to the supplemental restriction requirement set forth on page 4, applicants elect group G2 with traverse. We traverse this restriction on the ground that generic claims are allowable.

2. The Examiner has asked us to cite our authority for stating that before imposing a species restriction under PCT unity practice, the Examiner must establish a prima facie case of anticipation or obviousness against the generic claims.

The authority is the PCT Administrative Instructions, Annex B, paragraph (c)(i) ("no problem arises in the case of a genus/species situation where the genus claim avoids the prior art", referring to dependent species claims), and cp. paragraph (c)(ii)-(iii) explaining the basis for making a posteriori lack of unity objection.

The difference between PCT and domestic unity practice is that in PCT practice, the Examiner must cite art before making a holding of a posteriori (after consideration of prior art) lack

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of unity, whereas in domestic practice, the Examiner may require a species restriction without any preliminary showing. In both, of course, if generic claims are ultimately held patentable, the species restriction is withdrawn.

The Examiner has questioned whether the discussion of claim 18 on page 2 of the last election is an offer to admit that claim 18 should stand or fall with claim 1. It should be noted that even if the subject matter of claim 18 were to be considered obvious over that of claim 1 (and applicants don't wish to make a representation on that issue at this time), claim 18 might still be useful for distinguishing, e.g., a reference which inherently anticipates claim 1.

Under PCT unity principles, it is the Examiner's duty to consider, prior to action on the merits, whether claim 18 has a combination/subcombination relationship to claim 1; and we were merely speculating, from past prosecution experience, that the PTO was likely to give relatively little weight to the "another stomach-derived factor" added by claim 18.

Respectfully submitted,

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